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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/322,594	05/28/99	PETKOVSEK G	USA-P99-005

QM12/1220

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EXAMINER	
HENDERSON, M	
ART UNIT	**PAPER NUMBER**
3722	#5
DATE MAILED:	12/20/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
09/322,594	Glenn Petkovsek
Examiner	**Group Art Unit**
Mark T. Henderson	3722

☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-20 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-20 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☒ The drawing(s) filed on May 28, 1999 is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 5

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

Faxing of Responses to Office Actions

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXING of responses to Office Actions directly into the Group at (703)305-3579. This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: Reference "23" as stated on page 10, line 2, is not shown in the drawings. Correction is required.

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "23" and "13" have both been used to designate a "return receipt postcard". Correction is required.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "218" has been used to designate both "perforated tear lines" and an "auxiliary label". Correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-15, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Petkovsek (5,697,648).

Petkovsek discloses in Fig. 1, 2 and 6, a mailing assembly comprising a backing sheet (11), first and second mailing forms (10a and 10b) removably attached to the backing sheet by an adhesive (Col. 6, lines 21-25) and separable by a tear line (60) wherein the forms includes a first return postcard (18) and a designator section (24) within the first exterior sides (29a and 33a) that

define the postcard; wherein the first mailing form is removably attached (60) to the second mailing form; a first anchor portion (28) extending outside one of the exterior sides (33a) of the first return postcard, wherein the first anchor portion has adhesive (48) on the backside (Fig. 2), is removably attached to the postcard via a tear line (33) a removable label section (30) attached to the first anchor portion (28) via a tear line (32), a third designator section (36) contained within the first anchor portion, and a second anchor portion (27) removably attached to the return postcard by a tear line (29).

However, Petkovsek does not disclose a designator section; indicative of a special service which includes one of certified, registered, insured mail, COD and return receipt; having a machine readable code; and is distinctly colored.

In regards to Claims 1 and 7-9, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have any desirable indicia in the designator section since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack* 217 USPQ 401, (CAFC 1983). Also, in the present case, there appears to be no new or unobvious structural relationship between the printed matter and the substrate.

Furthermore in regards to Claim 8, matters related to the choice of ornamentation producing no mechanical effect or advantage considered to constitute the invention are considered obvious and do not impart patentability, *In re Seid* 73 USPQ 431.

In regards to Claims 13-15, the method for preparing a mailpiece for delivery is inherently taught by Petkovsek.

Note, the examiner also submits that the patent reference (Petkovsek) is considered prior art because it had issued more than one year prior to the actual filing date (5/28/99) of the application and application claims 1-15 recite subject matter not supported by the parent patent (Petkovsek). Therefore, the claims are not entitled to a date earlier than the actual filing date of this application. See MPEP 2133.01.

5. Claims 16-20, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Walz (5,664,725).

Walz discloses in Fig.1, 4 and 5, a mailing assembly comprising a first mailing form having a first postcard (70), a first anchor (58) and second anchor 57 removably attached to the postcard via a tear lines (24 and 26), wherein the first and second anchors have adhesive (16) on the backside of the anchors (seen in Fig. 5), a first and second backing strips (49) received over the adhesive on the anchor portion's backsides, a first designator section, and an area (66) contained within the postcard printed with machine readable code (75).

However, Walz does not disclose: a second mailing form having a second postcard and a second anchor portion; and a designator section indicative of a special service.

In regards to Claim 16, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have any desirable indicia in the designator section since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack* 217 USPQ 401, (CAFC 1983). Also, in the present case, there appears to be no new or unobvious structural relationship between the printed matter and the substrate.

Also, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include any desirable amount of mailing forms with postcards and anchor portions, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)305-3579. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.

MTH

December 13, 2000

A. L. WELLINGTON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700